

4172-120

REMARKS**Election of Group I Claims 1-68, 71, and 73-75 and Cancellation of Group II Claims 69, 70 and 72**

In the January 24, 2005 Office Action, the Examiner imposed a restriction requirement against originally filed claims 1-75, as between:

- Group I. Claims 1-68, 71, and 73-75; and
- Group II. Claims 69, 70, and 72.

Applicants hereby elect, without traverse, Group I claims 1-68, 71 and 73-75.

Correspondingly, the non-elected Groups II claims 69, 70, and 72 have been cancelled.

The cancellation of claims 69, 70, and 72 herein is with express reservation of the right to file one or more divisional patent applications directed to the subject matter of such cancelled claims, during the pendency of the present application or during the pendency of a further continuation or divisional patent application based on and claiming the priority of the present application.

Election of Species A Claims 1-68, 71 and 73-75 and Addition of Linking Claim 76

In the January 24, 2005 Office Action, the Examiner further required election of one of the following species:

- Species A: claims 1-43 and 56-68, directed to a method of forming polymeric hollow fibers by coating material on a core and removing the core;
- Species B: claims 44-55, directed to a method of forming polymeric hollow fibers by using a swellable coating material and contacting the material with a swelling agent to effect disengagement of the material from the core; and
- Species C: claims 73-75, directed to a method of forming polymeric hollow fibers where the substrate and the membrane materials are co-extruded,

In response, Applicants have hereby added new claims 76-80, among which independent claim 76 is a generic claim that links Species A-C; dependent claims 77-78 are readable on Species A; dependent claim 79 is readable on Species B; and dependent claim 80 is readable on Species C.

4172-120

Applicants hereby elect, with traverse, Species A for prosecution, on which original claims 1-43, 56-68, 71 and the newly added claims 76-78 are readable.

Applicants' reasons for the traversal of the restriction requirement are set out below, and on such basis, Applicants request the Examiner to reconsider the requirements for election of species, and to withdraw same in favor of consolidated examination and prosecution of claims 1-68, 71 and 73-80 of the present application.

First, 37 CFR 1.141 clearly provides that: "more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application..." and courts have also recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as Applicants have done herein. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention, regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

In this case, only three interrelated species (i.e., Species A-C) are claimed. They share common technical features, as recited by the newly added generic claim 76, and their relationship is sufficiently close to justify maintenance of claims for these species in the present application for search and examination purposes.

Therefore, Applicants hereby request the Examiner to reconsider, and upon reconsideration to withdraw, the requirement for election of species and examine all of the aspects of the present invention as specified in claims 1-68, 71 and 73-80, consistent with the statutory provisions and judiciary holdings as discussed hereinabove.

Further, the newly added claim 76 is generic to all three Species A-C and therefore constitutes a linking claim thereof.

The Manual of Patent Examination Procedure (MPEP) provides that:

4172-120

"[t]he linking claims must be examined with the invention elected, and should any linking claim be allowed, the restriction requirement must be withdrawn. Any claim(s) directed to the nonelected invention(s), previously withdrawn from consideration, which depends from or includes all the limitations of the allowable linking claim must be rejoined and will be fully examined for patentability."

(see MPEP, Section 809, Paragraph 6)

Therefore, if the Examiner insists in the requirement for election of species, Applicants then alternatively request the Examiner to exam the linking claim 76 together with the elected Species A claims 1-43, 56-68, 71, and 77-78, and upon subsequent allowance of such linking claim, to rejoin Species B and C claims 44-55 and 73-75 for patentability examination.

Payment of Fees for Adding New Claims 76-80

The fee payable for addition of new claims 76-80 is \$50.00, in view of the cancellation of claims 69, 70, and 72 herein. The Office is hereby authorized to charge the \$50.00 fee to the credit card specified in the Credit Card Payment form enclosed herewith.

Further, the Office is hereby authorized to charge any deficiency, and to credit any overpayment, associated with this Amendment to Deposit Account No. 08-3284 of Intellectual Property/Technology Law.

Respectfully submitted,



Yongzhi Yang
Reg. No. 56,310
Attorney for Applicants

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
P.O. Box 14329
Research Triangle Park, NC 27709
Telephone: (919) 419-9350
Fax: (919) 419-9354
Attorney Ref: 4172-120